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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,888	10/27/1999	CHRISTINE DUPUIS	05725.0473	3192

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/26/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/380,888

Applicant(s)

DUPUIS, CHRISTINE

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-21 and 24-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21 and 24-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 18-21, 24-53 are pending. The Amendment filed 1/16/03, Paper No. 23, cancelled claims 22-23, and amended claims 18, 24, 26, 28 and 30-34.

#### ***Response to Applicant's Arguments/Amendment***

The Applicant's arguments filed 1/16/03 (Paper No. 23) to the rejection of claims 18-53 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's amendment filed 1/16/03 (Paper No. 23) is sufficient to overcome the 35 USC 112 rejection in the previous Office Action.

The Terminal Disclaimer filed 1/16/03 (Paper No. 24) is sufficient to overcome the double patenting rejection in the previous Office Action.

#### ***103 Rejection Maintained***

The rejection of claims 18-21, 24-36, 39, 51-53 under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. (4,300,580) is MAINTAINED for the reasons set forth in the Office Action mailed 9/16/02, Paper No. 20, and those found below.

Applicant argues, "In particular, O'Neill does not teach, and neither does the Office address, the viscosity limitations of the aqueous gel of the claimed invention. . . At best, O'Neill discloses that the composition will have an inherent viscosity of at least 0.5. . . O'Neill, however, does not specify any ranges, shear strains, ratios, or any of the required parameters of the viscosity of the aqueous gel". This argument is not persuasive. The Examiner respectfully points out since O'Neill teaches the same composition as that of the instant invention, the

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composition of O'Neill must have the same properties, though O'Neill does not explicitly state such properties.

Applicant argues, "the Office never addresses how or why there would be a suggestion or motivation to quantitatively modify the mole percents of monomers taught in O'Neill to achieve the claimed invention. Rather, the Office improperly assumes that the general conditions of the claims are disclosed in O'Neill. . .however, with regard to the required viscosity parameters, the "general conditions" of the claimed invention are clearly not met by O'Neill". This argument is not persuasive. The Examiner respectfully points out a compound and its properties are inseparable (*In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)), and that the viscosity of a composition comprising a compound of formula (I) is directly correlated to the structure of formula (I), as formula (I) is a gelling agent. Thus, by modifying the mole percent of the "A" group, the viscosity of the composition would be met. The Examiner respectfully points out O'Neill teaches the compound of formula (I), wherein A is chosen from 1,4-phenylene and sulfo-1,3-phenyl groups, and optionally 1,3-phenylene groups, and n ranges from 2-4. Thus, O'Neill has disclosed the general conditions of such a compound, and where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233.

### ***103 Rejection Maintained***

The rejection of claims 18, 37-38, 40-50 under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. in view of Lee et al. (EP 0551748) is MAINTAINED for the reasons set forth in the Office Action mailed 9/16/02, Paper No. 20, and those found below.

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Applicant argues, "In the present case, the general guidance or shared commonality of the references, at best, is that they both disclose 'hair care compositions comprising sulfopolyesters in the form of sprays'. . . This shared commonality and/or general guidance, however, provides neither the parameters nor the direction on how to make or develop a device that comprises a container containing the composition of the present invention. . . Further, the Office does not address how or why there would be a reasonable expectation of success in combining the teachings of both references to even achieve the claimed invention". This argument is not persuasive. First, this argument is not commensurate in scope with the instant claims, which do not recite a method of making or developing a device. Second, the Examiner respectfully points out that there is a reasonable expectation of success, as both references are directed to hair care formulations comprising the same sulfopolyesters.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
February 14, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

2/23/03